

## **REMARKS**

Claims 1-16 are currently pending. Claims 1-16 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1 and 15 further stand rejected as obvious in view of U.S. Patent No. 5,355,638 (Hoffman) in combination with U.S. Patent No. 6,758,729 (Fujishiro).

Claim 1-8, 15, and 16 have been amended. Still further, paragraph 0033 of the specification has been amended to address certain obvious typographical errors. No new matter has been added to the Application.

### **Regarding the § 112 rejections**

Claims 1-8, and 16 have been amended in accordance with the Examiner's suggestions. Support for these amendments may be found, for example, at paragraphs 0035 and 0036 of the specification; no new matter has been added.

It is respectfully submitted that the Examiner's § 112 rejections are mooted by the above-mentioned amendments. As such, reconsideration and withdrawal of the rejections of these claims is earnestly solicited.

### **Regarding the § 103(a) rejections**

Claims 1 and 15 stand rejected as obvious in view of Hoffman in combination with Fujishiro. Applicant respectfully submits that the combination of the Hoffman and Fujishiro references fails to disclose, teach, or even suggest each and every limitation of Applicant's currently claimed inventions. As such, independent Claim 1 (and respective dependent Claim 15) are in condition for allowance. *See In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) (if an independent claim is non-obvious then any claim depending therefrom is non-obvious).

Examiner argues that Fujishiro discloses a vertical processor having a plurality of containers 60 with open tops, lids, and lifting mechanisms (the elements which include numeral 14 and are each attached to the lids with screws) which can be used to lift lids off of the open tops. *See Office Action* at page 5. The Examiner is in error.

Fujishiro does not teach, suggest, or disclose lifting mechanisms for lifting lids off of open containers. Fujishiro discloses a stopper 60 having a receiving member 63 that is fitted to recess 14 of lid 12. *See Figure 4*, and Col. 3, lines 50-59. The stopper 60 is further attached to

lower disk 42 (as shown with screws). *See Id.* As shown and described throughout the Fujishiro specification, lid 12 and stopper 60 are separate elements in communication through receiving member 63.

In operation, barrel 10, having lid 12, is ascended on piston 47 such that when the recess 14 of lid 12 collides with the receiving member 63 of the stopper 60 further ascent is prevented. *See Col. 4, line 53-Col. 5, line 5.* At the end of the operation cycle, barrel 10 and piston 47 are forced to be pushed downward together, *whereby a space is defined between the lid 12 and the receiving member 63 of the stopper 60*; a robot hand 97 is then operated to displace barrel 10 from piston 47. *See Col. 5, lines 33-59 (emphasis added).* So Fujishiro arguably discloses a mechanism to lift stopper 60 from barrel 10, however the mechanism fails to lift lid 12 from barrel 10. Interestingly, Fujishiro also even lacks any disclosure, teaching or suggestion as to a mechanism for putting lid 12 onto barrel 10.

To the extent that the Examiner argues that the Fujishiro mechanism can be used to lift lids off of the open tops, Applicant respectfully notes that the mere fact that a certain characteristic may be present is not sufficient to establish the existence of that characteristic. *See MPEP § 2112; In re Rijckaert*, 28 USPQ2d 1955 (Fed. Cir. 1993) (rejection based on what would result due to optimized conditions, not what was necessarily present in the prior art, was reversed). Consequently, the Examiner must show that the “missing descriptive matter is necessarily present in the thing described in the reference...[it] may not be established by probabilities or possibilities.” *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added). Simply put, Fujishiro lacks any disclosure, teaching, or suggestion regarding the placement of a lid off of, or even onto, a container. Thus the deficiencies of the Hoffman reference are not rectified by the combination of the Fujishiro reference.

In sum, Fujishiro lacks any disclosure, teaching, or suggestion regarding the removal of lid 12 from barrel 10. The combination of Hoffman and Fujishiro thus fails to provide each and every limitation of Applicant’s currently pending Claims 1 and 15. Applicant, therefore, respectfully requests reconsideration and withdrawal of the §103 rejections.

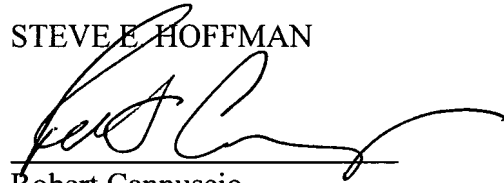
### **Allowable Claims**

Applicant appreciates the Examiner’s indication that claims 2-14 would be allowable upon addressing the §112 rejections. In light of the comments above, it is respectfully submitted that all the claims are now in condition for allowance in this case.

Should the Examiner have any questions or comments regarding Applicant's amendments or response, the Examiner is asked to contact Applicant's undersigned representative at (215) 988-3303.

Respectfully submitted,

STEVE E. HOFFMAN

A handwritten signature in black ink, appearing to read 'Robert Cannuscio', is written over a horizontal line.

Robert Cannuscio  
Registration No 36,469  
DRINKER BIDDLE & REATH LLP  
One Logan Square  
18<sup>th</sup> and Cherry Streets  
Philadelphia, PA 19103-6996  
Tel: (215) 988.3303  
Fax: (215) 988.2757

Attorney for Applicant